

## REMARKS

Reconsideration of the present application is respectfully requested in light of the above amendments to the application and the following remarks.

### Regarding the Drawings

The drawings are objected to under 37 CFR 1.83(a) because they fail to show a properly connected schematic as described in the specification. The objection was directed to Fig. 3, which has now been cancelled. In Fig. 2, the numbering of one component has been changed from 23 to 32 to be consistent with the specification, the label "23" has been moved, and certain text has been deleted.

### Regarding the Specification

The Title has been changed to be descriptive of the invention.

As Fig. 3 of the drawing has been cancelled, the reference to Fig. 3 in paragraph 009 (the brief description) has been cancelled; paragraph 0017 has been amended to refer to an embodiment rather than the first embodiment, paragraphs 0018 and 0019 have been cancelled, and the reference numerals in paragraph 0020 have been amended to be consistent with Fig. 2. It is respectfully submitted that the changes are supported by the drawings and the specification and do not constitute new matter.

### Regarding the Claims

Claims 1, 4 and 7 have been amended, and Claims 5, 6 and 8 have been cancelled. Currently pending in the application, therefore, are Claims 1 through 4 and 7, of which Claims 1, 4 and 7 are independent.

## REQUIREMENTS FOR A PRIMA FACIE CASE OF OBVIOUSNESS

To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Roy*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.P.A. 1974). (Emphasis added.)

### LACK OF PRIOR IMPLEMENTATION

If the claimed subject matter were an obvious extension of the art cited by the applicant or the Patent Office, it would have been implemented earlier. However, the cited art has not approached the problem from the viewpoint of the applicants, so the prior art has developed very different solutions for the problem. This supports Applicant's argument that the subject matter is allowable. "That an inventor has probed the strengths and weaknesses of the prior art and discovered an improvement that escaped those who came before is indicative of unobviousness, not obviousness." *Fromson v. Anitec Printing Plates, Inc.*, 45 U.S.P.Q.2d 1269 (Fed. Cir. 1997).

### NO MOTIVATION TO COMBINE REFERENCES

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references.

Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination"). Whether motivation to combine the references was shown we hold a question of fact. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[P]articular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes . . .") (emphasis added); Monarch Knitting, 139 F.3d at 881-83, 886, 45 USPQ2d at 1982, 1985 (treating motivation to combine issue as part of the scope and content of the prior art and holding that genuine issues of fact existed as to whether one of ordinary skill in the art would have been motivated to combine the references in question).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Although a reference need not expressly teach that the disclosure contained therein should be combined with another, see Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing

of combinability, in whatever form, must nevertheless be "clear and particular."

Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.<sup>1</sup>

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 2221 U.S.P.Q. 929, 933 (C.A.F.C. 1984).

Claim 7. Claim 7 was rejected under 35 U.S.C. §102(b) as being anticipated by Wong, et al. Claim 7, as amended, requires engaging an actuator switch which is "operable in a first position to momentarily short-circuit said electrically active conductor to said ground conductor, or operable in a second position to momentarily short-circuit said neutral conduct to said ground conductor". Wong does not disclose such momentary short-circuiting. Rather, Wong is concerned only with testing an arc fault interrupter circuit and discloses an apparatus which places a high di/dt signal on the electrical circuit for a predetermined period of time so as to simulate an arc and activate the arc fault detection circuitry. Note that Fig. 1b of Wong does not show a short-circuit of any kind. See the abstract, also see Wong column 3, lines 40-51, specifically referring to use of a current limiting resistor 60. Although Wong indicates testing of 60 amp breakers, Wong does so by placing a di/dt signal of 0.328 amps per 500 microseconds on the conductors. See Wong column 3, lines 62-65. See also Wong column 3, line 50 – column 4, line 3, regarding simulation of a line-to-ground arc by a 50 milli-amp ground fault signal by use of a ground fault resistor 14. Thus, Wong does not suggest or disclose the invention of claim 7. In addition, as Wong uses simulated signals and current-limited signals for testing, it would not be obvious to modify Wong to provide a short-circuit between any two conductors. Thus, under the case law cited above, it will be seen that the cited art does not disclose, suggest, or motivate one to modify the cited art to produce the claimed invention. Therefore, it is respectfully submitted that claim 7, as amended, is patentable over Wong.

---

<sup>1</sup> Quoted from WINNER INT'L. ROYALTY v WANG No. 981553 - 01/27/2000 (CAFC).

Claim 1. Claim 1 was rejected under 35 U.S.C. §103(a) as being unpatentable over Spear in view of Wong et al. Claim 1, as amended, requires “a) a double pole normally open switch” and further requires “(c) when said switch is operated in the first position said switch causes the electrically active conductor to be momentarily short-circuited to the ground conductor, thereby causing said overcurrent interrupt capability of said circuit breaker to cause said circuit breaker to open and said light emitting diode to cease emitting light; and (d) when said switch is operated in the second position said switch causes the neutral conductor to be momentarily short-circuited to the ground conductor, thereby causing said ground fault interrupt capability of said circuit breaker to cause said circuit breaker to open and said light emitting diode to cease emitting light.” As discussed above, Wong does not disclose such momentary short-circuiting as Wong is concerned only with testing an arc fault interrupter circuit and discloses an apparatus which places a high di/dt signal on the electrical circuit for a predetermined period of time so as to simulate an arc and activate the arc fault detection circuitry.

Spear discloses a tester but, like Wong, neither suggests nor discloses an active conductor-to-ground conductor momentary short-circuit, nor a neutral conductor-to-ground conductor momentary short circuit.

Thus, under the case law cited above, it will be seen that the cited art does not disclose, suggest, or motivate one to modify the cited art to produce the claimed invention. Therefore, even the combination of Spear and Wong does not disclose or suggest the invention of claim 1.

Claims 2 and 3. Claim 2 was rejected as being obvious in view of Spear. Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Spear in view of Wong et al. as applied to Claim 1, and further in view of Mason Jr. et al. Claims 2 and 3 depend from claim 1. As shown above, claim 1 is patentable over the cited art so claims 2 and 3 are also patentable over the cited art.

Claim 4. Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Spear in view of Wong. Claim 4, as amended, requires “c) a normally open double pole momentary switch”, further requires “e) when said switch is operated in the first position said switch causes the electrically active conductor to be momentarily short-circuited to the ground conductor”; and also requires “f) when said switch is operated in the second position said switch causes the

neutral conductor to be momentarily short-circuited to the ground conductor.” As discussed above, Wong does not disclose such momentary short-circuiting as Wong is concerned only with testing an arc fault interrupter circuit and discloses an apparatus which places a high di/dt signal on the electrical circuit for a predetermined period of time so as to simulate an arc and activate the arc fault detection circuitry.

Spear discloses a tester but, like Wong, neither suggests nor discloses an active conductor-to-ground conductor momentary short-circuit, nor a neutral conductor-to-ground conductor momentary short circuit.

Thus, under the case law cited above, it will be seen that the cited art does not disclose, suggest, or motivate one to modify the cited art to produce the claimed invention. Therefore, even the combination of Spear and Wong does not disclose or suggest the invention of claim 4.

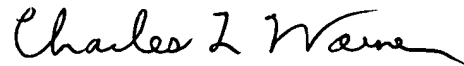
Applicant respectfully submits that Claims 1-4 and 7, as amended, are now distinguishable over the cited art, that the cited art neither anticipates nor renders obvious the amended claims, and that the claims, as amended, are now in condition for allowance. Applicant therefore respectfully requests that a Notice of Allowability be issued for the claims.

#### DOCTRINE OF EQUIVALENTS

Some amendments and remarks contained in this document, or in other documents filed or to be filed with the US Patent Office in this case or related cases, may in the future be deemed, by a court of law or government agency of competent jurisdiction, to be narrowing amendments and/or related to patentability. Accordingly, the public is hereby advised that the applicant: (a) intends to relinquish only that claim coverage which is clearly, explicitly, precisely and unequivocally stated to be relinquished; (b) does not intend to relinquish any other claim coverage; (c) reserves the right to assert that any such amendments and/or remarks are not narrowing and/or are not related to patentability; and (d) intends to fully assert the full range of equivalents, under the Doctrine of Equivalents and otherwise, which are presently known or which may become known in the future, for each and every element of each and every claim, and for each and every claim.

Should the Examiner have questions or suggestions which will put this application in condition for allowance, a telephone call to the undersigned attorney is respectfully requested.

Respectfully submitted,  
POWELL GOLDSTEIN LLP



By: Charles L. Warner II  
Reg. No. 32,320

One Atlantic Center  
Fourteenth Floor  
1201 West Peachtree Street, N.W.  
Atlanta, Georgia 30309-3488  
(404) 572-6718  
cwarner@pogolaw.com



**BEST AVAILABLE COPY**